

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed March 7, 2005. Through this response, claims 1 and 21 have been amended, and claim 24 has been cancelled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 1, 6, 15, 17, 19-23, and 25-28 are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 112, First Paragraph

Claims 23-28 have been rejected under 35 U.S.C. § 112, first paragraph. With regard to the rejection of claims 23 and 25 under 35 USC 112 first paragraph, Applicant respectfully traverses this rejection. Claims 23 and 25 are reproduced below:

23. The method of claim 21, wherein providing configuration information comprises posting the configuration information to a web page using an embedded web server of the peripheral device.

25. A peripheral device, comprising:
a scanner;
an embedded web server configured to collect and post peripheral device configuration information; and
a customer support unit configured to facilitate communications between a peripheral device user at the peripheral device and a customer support representative, the customer support unit including a microphone that collects voice data of the user, a speaker that emits voice data of the representative, and network interface devices that enable transmission of the data between the user and the representative.

Page 7 of Applicant's specification, lines 1-2 provides that the "memory 206 includes an operating system 220, a communications module 222, and a web server module 224." Page 7 of Applicant's specification, lines 18-19, also provides (with emphasis added) that "the module 224 can collect information as to the configuration of the

electrical device 102, all device settings that have been selected, and any error messages (e.g., from an error log maintained by the device 102) that reflect any malfunctions the device has experienced. Once this information is collected, it is stored by the module 224, as indicated in block 302. The stored information can be formatted, as indicated in block 304, for insertion into one or more web pages generated by the web server module 224. So, as is evident from Applicant's specification, the web server module 224 in one embodiment may comprise software that generates web pages and collects information for the web pages.

Applicant has prepared the attached 1.132 affidavit with regard to well-established meanings of an "embedded web server." In particular, Applicant has attached Exhibits A-B. Exhibit A is a page from a web-site entitled, "TechWeb: TechEncyclopedia." The page provides that a web server "delivers web pages to browsers and other files to applications via the HTTP protocol." The web page also states that the term "web server" may "refer to just the software and not the entire computer system." As noted from the Applicant's specification, one embodiment of a web server module 224 may be software stored in memory 206.

Additionally, Exhibit B is a page from a web-site entitled, "TechWeb: TechEncyclopedia," and defines an embedded web server as "web server software embedded within a hardware device such as a print server." As established above, the web server module 224 can be software that generates web pages, and hence can be a web server. Further, the sections cited above from Applicant's specification are disclosed as components of an electrical device 102 (see page 5, lines 15-16). Page 5, lines 1-6 provides the following description of an electrical device 102:

When the electrical device 102 is a peripheral device, it can be substantially any peripheral device with which a user may require support. For example, the peripheral device can comprise a printer,

photocopier, facsimile machine, scanner, digital sender, multi-function peripheral, *etc.*
within a hardware device.

Clearly, this list of devices falls within the category of hardware devices. Thus, the web server module 224 can be software embedded within a hardware device.

Finally, the Applicant has declared in the 1.132 affidavit that claims 23 and 25 are sufficiently supported in the specification under 35 USC 112, first paragraph to enable one skilled in the art to which it pertains to make and/or use the embodiment of the invention described in claims 23 and 25. Thus, Applicant respectfully submits that the rejection to claims 23 and 25 under 35 USC 112, first paragraph has been overcome and request that the rejection be withdrawn.

Since claims 24 and 26-28 depend from claims 23 and 25, respectively, Applicant requests that the rejection under 35 USC 112, first paragraph be withdrawn for similar reasons stated above for claims 23 and 25.

II. Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 23-28 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Applicant respectfully traverses this rejection. The Office Action provides the following statement on page 3, section 5:

Regarding claims 23 and 25, it is unclear how a peripheral device comprising an embedded web server because it is old and notoriously well known in the art that peripheral device is referred a device that is connected to a computer and is controlled by computer's microprocessor, and the web server is referred to a computer running administrative software that controls access to a local area network. Thus, it is impossible to embed a web server, i.e., a computer running administrative software that controls access to a local area network, in a peripheral device, i.e., a device that is connected to a computer and is

controlled by computer's microprocessor, according to their defined structure.

It appears from the statement above that the Examiner's presumes that peripheral devices are known in the art as devices that are connected to a computer and controlled by a computer's microprocessor, and further that the Examiner does not understand how one can embed software with web server functionality in a peripheral device because to do so in light of the Examiner's understanding of the current state of the art is impossible. Initially, Applicant concurs that, implicit in the Examiner's statement, the claims define embodiments that are truly novel. Also, Applicant has included with this response a 1.132 affidavit declaring that the specification fully supports and enables one skilled in the art how to make and use a peripheral device having an embedded web server. It is respectfully asserted that since claims 23-28 define the invention in the manner required by 35 U.S.C. § 112, second paragraph, Applicant respectfully requests that the rejection to these claims be withdrawn.

Since claims 24 and 26-28 depend from claims 23 and 25, respectively, Applicant requests that the rejection under 35 USC 112, first paragraph be withdrawn for similar reasons stated above for claims 23 and 25.

III. Claim Rejections - 35 U.S.C. § 103(a)

A. Statement of the Rejections

Claims 1, 6 and 21-22 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hube* ("Hube," U.S. Pat. No. 5,694,528) in view of *Peters* ("Peters," U.S. Pat. No. 5,769,269). Claims 15, 17, 19, 20, 23, and 24 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hube* in view of *Peters* and *Venkatraman et al.* ("Venkatraman," U.S. Pat. No. 6,170,007). Claims 25-26 have been rejected under

35 U.S.C. § 103(a) as allegedly unpatentable over *Hube* in view of *Venkatraman*. Claims 27-28 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hube* in view of *Venkatraman* and further in view of *Peters*. Applicant respectfully traverses these rejections.

B. Discussion of the Rejections

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant’s disclosure.

In the present case, Applicant respectfully submits that a *prima facie* case of obviousness has not been shown.

Independent Claim 1

Claim 1 recites (with emphasis added):

1. A method for providing customer support to a peripheral device user, comprising the steps of:

receiving a request from a user to contact a customer support representative with a customer support unit integrated with a peripheral device that is one of a printer, photocopier, facsimile machine, scanner, digital sender, or multifunction peripheral;

establishing a communications link between the customer support representative and the user with the customer support unit;

transmitting audio and video communications between the customer support representative and the user while the user is at the peripheral device via the customer support unit; and

presenting status and settings information from the peripheral device to the customer support representative **while the audio and video transmission is active** to enable the customer support representative to consult the user as to how the user can correct a problem with the peripheral device.

Applicant respectfully submits that the amendments to claim 1 render the rejection moot. In particular, neither *Hube* nor *Peters* discloses, teaches, or suggests the emphasized claim features. The Office Action cites column 7, line 34 through column 9, line 25 for supporting the assertion that *Hube* meets the emphasized claim features. These cited sections of *Hube* appears to disclose "a technique for diagnosing image data generated at the printing system." (See column 7, lines 6-7) Column 8, lines 36-38 provides that the fax page sent by the printing device is configured with a section that contains "system or other data while section 252 is configured to contain fault summary or description." FIG. 11 which corresponds to the this section of the *Hube* specification shows system data to be categorized as machine number and operator in the system data portion of the fax page, which is not the same as **presenting status and settings information**. *Peters* fails to remedy these deficiencies. In column 16, lines 3-6, *Peters* provides that "when a communications link is established, the CSR operator can switch to a data mode so as to access the vending machine 30 databases in

order to determine machine status and inventory.” Nothing in this section of *Peters* discloses that the machine status in *Hube* is also *settings information*. Second, it appears that the “status information” in *Hube* is not presented *while the audio and video transmission is active*, but in contrast, appears to be presented sequentially through the use of an operator switch. Since *Hube* and *Peters* fails to disclose, teach, or suggest all the claim limitations, a *prima facie* case of obviousness has not been made. Thus, Applicant respectfully requests that the rejection to independent claim 1 be withdrawn.

Because independent claim 1 is allowable over *Hube* and *Peters*, dependent claim 6 is allowable as a matter of law for at least the reason that the dependent claim 6 contains all elements of its respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). In addition, dependent claim 6 is allowable other grounds. For instance, *Hube* does not disclose *permitting the customer support representative to change settings of the peripheral device while the communications link is active so that the user can confirm that the problem has been corrected before breaking contact with the customer service representative*. The Office Action cites col. 9, lines 4-25 to support the allegation that *Hube* teaches the features found in dependent claim 6. The cited section provides as follows:

It will be understood that a variety of diagnostic operations can be performed by reference to a print including the information of formatted FAX page 249 (FIG. 11). In one example, the formatted page includes an image with an undesirable artifact and the CSR determines an image processing adjustment to be performed at the printing system 2. Such adjustment may include an adjustment to image segmentation of the type discussed in U.S. Pat. No. 5,339,172 to Robinson.

It will be further understood that the term "diagnosis" is used by the present disclosure to encompass a variety of meanings. For instance, as used herein a "diagnostic operation" may include nothing more than guiding a current printing system operator through a confusing routine. That is, the CSR may, in one example, view a dialog screen

representation, and indicate to the current printing system operator a course of action to be taken for advancing through a desired printing system routine. Hence, while a diagnostic operation will, in one instance, include some sort of analysis on the part of the CSR, such operation may not require the implementation of a diagnostic routine at the printing system.

Nothing in this cited section discloses, teaches, or suggests the emphasized claim features. In fact, this section reproduced above appears to teach that a CSR can detect an artifact in a faxed image and make recommendations as to the adjustments required at the printing device. If an adjustment is not required, it may be because the purpose of the communication is to simply guide a user through the operation of the printing system. *Peters* does not remedy this deficiency. *Peters* provides in column 11, lines 30 that once "communications are established with the CSR site diagnosis and corrections to the machine can occur remotely." However, this section of *Peters* appears to be described in the context of vending machine start-up, and no mention is made of *establishing a communications link between the customer support representative and the user with the customer support unit* during this process. Thus, Applicant respectfully submits that a *prima facie* case of obviousness has not been made, and request that the rejection to dependent claim 6 be withdrawn.

Independent Claim 21

Claim 21 recites:

21. A method for providing customer support to a peripheral device user, comprising:

receiving a customer support request from a peripheral device user input by the user into the peripheral device that is one of a printer, photocopier, facsimile machine, scanner, digital sender, or multifunction peripheral;

establishing a communications link between a customer support representative and the user with a customer support unit that is integrated with the peripheral device in response to the received support request;

providing configuration information about the peripheral device to the customer support representative while the communications link is active, the information being provided directly by the peripheral device;

transmitting communications of the customer support representative to the user while the user is at the peripheral device via the customer support unit;

transmitting communications of the user to the customer support representative while the user is at the peripheral device via the customer support unit; and

permitting the customer support representative to change a setting on the peripheral device remotely while the communications link is active.

Applicant respectfully submits that the amendments to claim 21 render the rejection moot. In particular, neither *Hube* nor *Peters* discloses, teaches, or suggests the emphasized claim features. The Office Action cites col. 9, lines 4-25 to support the allegation that *Hube* teaches the emphasized features found in independent claim 21. This cited section, as explained above, appears to teach that a CSR can detect an artifact in a faxed image and make recommendations as to the adjustments required at the printing device. If an adjustment is not required, it may be because the purpose of the communication is to simply guide a user through the operation of the printing system. *Peters* does not remedy this deficiency. *Peters* provides in column 11, lines 30 that once “communications are established with the CSR site diagnosis and corrections to the machine can occur remotely.” However, this section of *Peters* appears to be described in the context of vending machine start-up, and no mention is made of ***an active communications link between the customer support representative and the user with the customer support unit*** during this process. Thus, Applicant respectfully submits that a *prima facie* case of obviousness has not been made, and request that the rejection to independent claim 21 be withdrawn.

Because independent claim 21 is allowable over *Hube* and *Peters*, dependent claims 22-23 are allowable as a matter of law.

With regard to the rejection of claims 23-24 by *Hube* in view of *Peters* and *Venkatraman*, Applicant respectfully traverses this rejection, and defer the discussion to the discussion below.

Independent Claims 15, 20, and 25 and dependent claims 15, 17, 19, 23-24, and 26-28

Applicant respectfully asserts that the proposed combinations of *Hube* in view of *Peters* and *Venkatraman* (claims 15, 17, 19, 20, 23, and 24), *Hube* in view *Venkatraman* (claims 25-26), and *Hube* in view of *Venkatraman* and further in view of *Peters* (claims 27-28) are improper. It has been well established that teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, there must be a teaching in the relevant art which would suggest to a person having ordinary skill in that art the desirability of providing a web server module in a peripheral device to assist in the communication of status and settings information via a web page and troubleshooting of a peripheral device between a customer service representative and a user at the peripheral device. Nothing in *Hube* or *Peters* suggests the use of embedded web servers to achieve the mechanisms disclosed in each reference. The Office Action's rationale for the combination of *Hube* and *Peters* with *Venkatraman* is because "it enables low cost widely accessible and enhances user interface functions for the peripheral device." These generalized statements as to a grounds for combining references do not comport with the requirement that the rationale to modify or combine rely on logic and sound scientific reasoning (see *Ex Parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

Additionally, one skilled in the art would not be motivated to combine *Hube* and *Peters* with *Venkatraman*, since they are not in analogous arts. As provided in MPEP 2141.01(a), “[I]n order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned.” The Office Action on page 5 alleges that “Hube and Peters are properly combinable because they are in the same field of endeavor, i.e., establishing a communication between customer and customer support representative.” Assuming *arguendo* this to be a valid statement, the stated endeavor is quite clearly in contrast to providing interfaces for devices to provide enhanced and widely accessible user interface functions.

Further, the proposed modification to *Hube* by *Venkatraman* would quite significantly alter the principle of operation of *Hube*. That is, with the web-site feature, the use of facsimile devices to send images of a screen would likely be rendered obsolete if they can be done real-time through the use of a web page. This change in principle of operation is improper according to MPEP 2143.02.

Thus, Applicant respectfully submits that the proposed combination of *Hube* and *Peters* and *Venkatraman* or *Hube* and *Venkatraman* is improper, and request that the rejection to claims 15, 20, and 25 and dependent claims 15, 17, 19, 23, and 26-28 be withdrawn. Because independent claims 15 and 25 are allowable over the proposed combination, dependent claims 17 and 19 and 26-28, respectively, are allowable as a matter of law.

In summary, it is Applicant’s position that a *prima facie* for obviousness has not been made against Applicant’s claims 1, 6, 15, 17, 19-23, and 25-28. Therefore, it is

respectfully submitted that each of these claims is patentable over the cited references and that the rejection of these claims should be withdrawn.

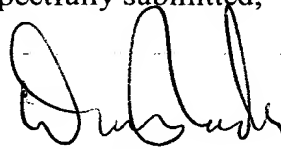
IV. Canceled Claims

As identified above, claim 24 has been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicant reserves the right to present this canceled claim, or variants thereof, in continuing applications to be filed subsequently.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David Rodack', is written over a horizontal line.

David Rodack
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